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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

#30

IN RE APPLICATION OF

:

GREG BENSON, ET AL.

: EXAMINER: VON BUHR, M.

SERIAL NO: 09/321,386

:

FILED: MAY 27, 1999

: GROUP ART UNIT: 2125

FOR: METHOD AND SYSTEM FOR
MANAGING A DATA OBJECT SO
AS TO COMPLY WITH
PREDETERMINED CONDITIONS
FOR USAGE

:

37 CFR 1.607 REQUEST FOR AN
INTERFERENCE WITH TWO PATENTS

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313
SIR:

I. 37 CFR 1.607(a)(1)

The patent is U.S. patent No. 5,920,861 and 6,138,119 issued July 06, 1999 and October 24, 2000, respectively, and both naming Hall et al. as inventors. The assignee at issue was InterTrust Technologies Corporation for both patents.

II. RELEVANT FIELD AND LEVEL OF ORDINARY SKILL IN THE ART

The relevant field is digital rights management (DRM). That field is further defined in CEN/ISSS Digital Rights Management Draft Report, Exhibit A. See paragraph (7) of Exhibit B.

A person of ordinary skill in the art of DRM in the 1995 to 1996 timeframe had 5 to 7 years experience in audio/video compression technology and 1 to 3 years experience in Internet transport and e-commerce. Further, a person of ordinary skill in the art of DRM in

that timeframe was knowledgeable concerning international copyright laws and means/methods for protecting copyrighted content. See paragraph (8) of Exhibit B.

III. 37 CFR 1.607(A)(2)

A. Proposal

Applicants propose the following count, which is in the format approved by the Commissioner in Orikasa v. Oonishi, 10 USPQ2d 1999, 2003 (Comm'r 1990), and Davis v. Uke, 27 USPQ2d 1180, 1188 (Comm'r 1993):

Claim 58 in the '861 patent

OR

Claim 48 in the instant application.

Claim 58 of the '861 patent recites:

A method of creating a first secure container, said method including the following steps;

accessing a descriptive data structure, said descriptive data structure including or addressing

organization information at least in part describing a required or desired organization of a content section of said first secure container, and

metadata information at least in part specifying at least one step required or desired in creation of said first secure container;

using said descriptive data structure to organize said first secure container contents;

using said metadata information to at least in part determine specific information required to be included in said first secure container contents; and

generating or identifying at least one rule designed to control at least one aspect of access to or use of at least a portion of said first secure container contents.

Claim 48 of the instant application recites:

A method of managing a data object so as to comply with control conditions for usage of the data object, comprising:

storing a data object in the memory of a data object provider processor;

providing a variable number of control conditions for usage of the data object; and

providing a set of control data for the data object based on the variable number of control conditions for usage, the set of control data comprising at least one or more usage control elements defining usages of the data object which comply with the variable number of control conditions.

Claims 48 and 58 do not recite identical language. However, Applicants submit that (1) the subject matter defined by claim 58 would have been obvious to a person of ordinary skill in the art during the 1995 to 1996 timeframe in view of the subject matter defined by claim 48 and (2) that the subject matter defined by claim 48 would have been obvious to a person of ordinary skill in the art during the 1995 to 1996 timeframe in view of the subject matter defined by claim 58. See paragraphs (9)-(11) of Exhibit B.

B. The Subject Matter Defined by Claim 48 would have been Obvious in View of the Subject Matter Defined by Claim 58

Claim 48 of the instant application recites the step of “storing a data object in the memory of a data object provider processor” The preamble of claim 58 recites “a method of creating a first secure container,” and the body of claim 58 provides for generating at least one rule to control use of the first secure container. Hence, claim 58 is directed to a method executed by a data object provider. Applicants submit that it is inherent in the subject matter of claim 58 that the data object, which forms part of the secure container contents, is stored in the memory of a data object provider processor. See paragraph (12) of Exhibit B.

Claim 48 of the instant application further recites the steps of:

providing a variable number of control conditions for usage of the data object; and

providing a set of control data for the data object based on the variable number of control conditions for usage, the set of control data comprising at least one or more usage control elements defining usages of the data object which comply with the variable number of control conditions.

Likewise, claim 58 recites the step of “generating or identifying *at least one rule* designed to control at least one aspect of access to or use of at least a portion of said first secure container contents.”¹ Applicants submit that there is no patentable distinction between the last two steps of claim 48 of the instant application and the generating step recited in claim 58. See paragraph (13) of Exhibit B.

Consequently, the subject matter defined by claim 48 defines the same patentable subject matter as claim 58, and one-half of the required two-way obviousness test is satisfied. See paragraph (14) of Exhibit B.

C. The Subject Matter Defined by Claim 58 would have been Obvious in View of the Subject Matter Defined by Claim 48

Claim 58 recites the step of:

accessing a descriptive data structure, said descriptive data structure including or addressing

organization information at least in part describing a required or desired organization of a content section of said first secure container, and

metadata information at least in part specifying at least one step required or desired in creation of said first secure container

Claim 48 of the instant application does not explicitly recite this step. However, the step of providing a set of control data for the data object encompasses accessing header elements of the control data which are the descriptive data structure recited in claim 58 by another name. By way of non-limiting example, the Applicants’ specification teaches at page 10 lines 21-24 that the header information includes an object identifier, a title of the data object, and a format code specifying any format module to be used for converting the format of the data object. See paragraph (16) of Exhibit B.

¹ Italics added for emphasis.

Further, U.S. patent No. 5,862,325 to Reed et al. (hereinafter “the Reed patent”)² is directed to a communication system that coordinates the transfer of data, *metadata*, and instructions between databases of a provider and a consumer in order to control and process communication of content data. The Reed patent teaches particular means/methods for utilizing descriptive data structures to provide intelligence in creating and publishing communications objects. See paragraph (17) of Exhibit B.

The Reed patent illustrates in Figure 3 an object oriented data model for storing communication data. The Reed patent teaches in column 20 lines 30-49 that, in order to organize elements (content) which are contained in a communications object, one must have one or more container classes. The page container class 142 associates one or more reference instances 146. The reference instances 146 associate the elements (content) with the page and enable control of the display order of the elements (content) on the page. Each element (content) must be assigned to at least one page in order to be transmitted with an object. See paragraph (18) of Exhibit B.

Further, the Reed patent teaches in column 20 line 50 - column 21 line 8 that method class 141 is a form of metadata. One purpose of the method class 141 is to execute procedures in the provider program which create communications objects. Further, the Reed patent teaches at column 19 lines 20-36 that query elements associated with method class 141 allow a provider to execute a query against a local or network database and have the results (specific information) included in the transmission of a communications object. See paragraph (19) of Exhibit B.

Accordingly, Applicants submit that it would have been obvious to a person of ordinary skill in the art during the 1995 to 1996 timeframe to modify the method recited in

² A copy of the Reed patent is Exhibit C. The Reed patent is 35 USC 102(e) prior art against the two target patents.

claim 48 to include the specific limitations (e.g., the use of metadata) of the accessing step of claim 58 because descriptive data structures including organization information and metadata information were known to provide intelligence in creating and publishing communications objects. See paragraph (20) of Exhibit B.

Claim 58 further recites the steps of:

using said descriptive data structure to organize said first secure container contents;

using said metadata information to at least in part determine specific information required to be included in said first secure container contents

Claim 48 does not explicitly recite those steps. However, as noted above, the set of control data recited in claim 48 includes header information that is equivalent to the descriptive data structure of claim 58. Moreover, the header information (e.g., formatting code) may be used to “organize” the secure container contents. Further, Applicants submit that it would have been obvious to a person of ordinary skill in the art during the 1995 to 1996 timeframe to use the descriptive data structure to organize and create a secure container. As discussed above, the Reed patent teaches organizing communications objects and determining specific information required or desired in creation of a communications object. See paragraph (22) of Exhibit B.

Finally, claim 58 recites the step of “generating or identifying at least one rule designed to control at least one aspect of access to or use of at least a portion of said first secure container contents.” As discussed above, Applicants submit that there is no patentable distinction between the two step “providing” passage of claim 48 of the instant application and the generating step recited in claim 58. Hence, the subject matter defined by claim 58 of the ‘861 patent would have been unpatentable (obvious) over the subject matter of claim 48 in view of the teachings of the Reed patent, and the second-half of the required two-way obviousness test is satisfied. See paragraph (23) of Exhibit B.

IV. 37 CFR 1.607(a)(3)

Claims 1-4, 11-13, 34-38, 40-43, 56-58, 63, 64, 67, 68, 71-76, 79-82, and 93-101 of the '861 patent correspond to the proposed count. These claims all merely recite standard programming design choices made as a consequence of using descriptive data structure to organize and create a secure container. See paragraph (24) of Exhibit B.

Claims 1-28, 30-42, 51, 53-57, and 59-63 of the '119 patent correspond to the proposed count. Applicants note that all of the claims of the '119 patent were subject to a double patenting rejection over the claims of the '861 patent and that InterTrust filed a terminal disclaimer in response thereto--thereby essentially conceding that the claims of the '119 patent are not patentably distinct from the claims of the '861 patent.

V. 37 CFR 1.607(a)(4)

Claims 30-51, 54, and 56-69 of the 09/164,606 application correspond to the proposed count.

Claims 1-22 and 25-53 of the instant application correspond to the proposed count.

VI. 37 CFR 1.607(a)(5)

37 CFR 1.607(a)(5) is inapplicable because all of the claims of the instant application and the '606 application were in the application and deemed allowable prior to the filing of this request.

VII. 37 CFR 1.607(a)(6)

During a November 05, 2003 telephone conference held between Administrative Patent Judge Lee, counsel for InterTrust, and the undersigned, it was agreed that InterTrust reserved the right to challenge Applicants' claims under 35 USC 135(b) if an interference is declared.

**VIII. REQUEST FOR THE BENEFIT OF THE FILING DATES
OF APPLICANTS' PRIORITY APPLICATIONS**

Applicants claim priority under 35 USC 120 based upon U.S. application serial No. 08/594,811, which was filed on January 31, 1996. The '811 application matured into U.S. patent No. 5,845,281. Applicants further claim priority under 35 USC 120 based upon the '606 application, which was filed on October 01, 1998. The '606 application is a continuation of the '811 application and the instant application is a continuation of the '606 application. Applicants are entitled to the benefit of the filing dates of their earlier filed applications for interference purposes if the count reads on at least one adequately disclosed embodiment in the earlier application.³ Assuming that the examiner recommends to the board applicants' proposed count, applicants clearly meet that standard. This is so because this application is a continuation application from the '811 and '606 applications. Consequently, applicants' earlier filed U.S. application has the same disclosure as the instant application.

Furthermore, Applicants claim priority under 35 USC 119 for both the '386 application and the instant application based upon Swedish application 9500355-4, which was filed on February 01, 1995.⁴ That applicants' proposed count reads on at least one adequately disclosed embodiment in the Swedish priority application is shown below.

48. A method of managing a data object so as to comply with control conditions for usage of the data object, comprising:	See Figures 1, 3, and 5
storing a data object in the memory of a data object provider processor;	Figure 1 elements 11 and 24 and Figure 3.
providing a variable number of control conditions for usage of the data object; and	Figure 5 step 7050 and page 12 lines 7-21.
providing a set of control data for	Figure 5 step 7050 and page 12

³ Weil v. Fritz, 572 F.2d 856, 865-66 n.16, 196 USPQ 600, 608 n.16 (CCPA 1978).

⁴ A copy of the Swedish application, which was originally written in English, is Exhibit E.

the data object based on the variable number of control conditions for usage, the set of control data comprising at least one or more usage control elements defining usages of the data object which comply with the variable number of control conditions.

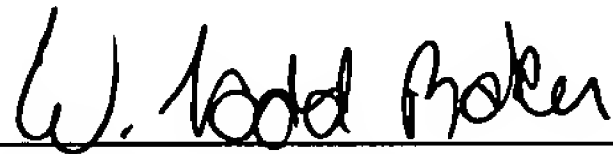
lines 7-21.

IX. 37 CFR 1.608

37 CFR 1.608 is irrelevant since the effective filing date of this application and the '606 application (i.e., January 31, 1996) precedes the effective filing date of the two target patents (i.e., February 25, 1997).

For the foregoing reasons, the party Benson should be the senior party in the requested interference.

Respectfully submitted,



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